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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,536	08/31/2001	Lee C. Moore	D/A0A45	3291
7590	08/17/2010		EXAMINER	
Patrick R. Roche, Esq. Fay, Sharpe, Fagan, Minnich & McKee, LLP 1100 Superior Avenue, 7th Floor Cleveland, OH 44114-2518			WALSH, DANIEL I	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/944,536	Applicant(s) MOORE, LEE C.
	Examiner DANIEL WALSH	Art Unit 2887

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(o).

Status

1) Responsive to communication(s) filed on _____.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 2 and 6-8 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
 5) Claim(s) ____ is/are allowed.
 6) Claim(s) 2 and 6-8 is/are rejected.
 7) Claim(s) ____ is/are objected to.
 8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on ____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date _____.
 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____.
 5) Notice of Informal Patent Application
 6) Other: _____

DETAILED ACTION***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1, 6, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jeffrey et al. (US 20020083090).

Re claim 1, Jeffrey et al. teaches scanning a printed version of the document to generate scan data; performing optical character recognition functions on the scan data to generate an electronic version of the document (paragraph [0023]); determining sub section delimiters by a user indicating at least one of a font size, a font style, a text string, a text location description, specific point coordinate or a user placing a predetermined machine readable symbol representing a demarcation point on a printed version of the document as the sub section delimiter and generating the index for the document with all found items corresponding to the sub section delimiter characteristics (paragraph [0024] which teaches that at least one bookmark can be generated and location can be identified by criteria including font size, change in font, new paragraphs or any other desired element and also teaches the manual input and editing to add/create/delete bookmarks, wherein the index is automatically generated). Though silent to a sub section delimiter definition including at least one delimiter characteristic, the Examiner notes that as the criterions are able to be selected/edited/changed, that it would have been obvious for one

Art Unit: 2887

of ordinary skill in the art that certain characteristics can be used as a delimiter definition including a delimiter characteristic, such as perhaps larger fonts could be defined as titles/chapters, etc. Since the criteria are customizable based on how the index is desired to be created, it would have been obvious to have desired definitions set up based on how the subsections would be separated (how the document would be broken up) in order to organize the document into a particular searched form (indexed).

Re claim 6, paragraph [0026] teaches that the bookmarks of the index can be displayed with a document or alone, and as discussed above, that the bookmarks can be edited/added/deleted. FIG. 27 provides an example of a canned image of a document including the list of bookmarks/index. Therefore, this is broadly interpreted as displaying. Correction/editing has been discussed above, and would be an obvious expedient to edit/correct/change bookmarks/index such as for correction for example.

Re claim 7, the limitations have been discussed above, wherein the different criteria set up to create bookmarks of the index can be interpreted as subsection titles (or any user definable section divider for indexing/bookmarks), such being the desired form of indexing based on the document/user/etc. Accordingly, searching the document to find occurrences of the items corresponding to the defined sub-section delimiter can be interpreted as selecting a title/paragraph break, change in font, etc. (such as a user picking/selecting the first title and recognizing that it is an enlarged font/paragraph break for example) and then setting the criteria for book marking subsequent occurrences of this type of defined sub section delimiter corresponding to this selected sub section title.

2. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jeffrey et al., as discussed above, in view of Saito et al. (US 6353840)

The teachings of Jeffrey et al. have been discussed above.

Jeffrey et al. is silent to displaying a plurality of pages on a user interface to select at least one demarcation point on at least one of the plurality of pages; and using the at least one demarcation point as the defined sub section delimiter. Jeffrey et al. teaches change in font, font size, etc., and other means, but is silent to specifically a demarcation point as a sub section delimiter.

Saito et al. teaches that a search template for the system can be user defined including coordinates, indentation, font size, font type, etc. (FIG. 15), interpreted as a demarcation point as a sub section delimiter. Saito et al. shows at least one page being displayed where the user can pick areas (FIG. 10+, 13), thus obviating on screen display and selection, related to the claims. A plurality of pages would have been obvious such as when the document has a plurality of pages, as Jeffrey et al. teaches a plurality of pages.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Jeffrey et al. with those of Saito et al.

One would have been motivated to do this to permit for locating relevant areas for indexing/bookmarks also based on coordinates/demarcation points, such as though known in advance, to aid in generation of bookmarks/indexes. As the criteria are user selected, based upon scanned in documents, the Examiner notes it would have been obvious to one of ordinary skill in the art for the pages to be displayed in order for the user to view the document to determine criteria to be used.

Art Unit: 2887

3. Applicant's arguments filed, including the 1.131 affidavit have been fully considered but they are not persuasive.

The examiner notes that the actual dates of acts relied on to establish diligence must be provided (see MPEP 715.07(a)). Further, MPEP 705.07(a) recites under 37 CFR 1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice, either actual or constructive (i.e., filing a United States patent application). Note, therefore, that only diligence before reduction to practice is a material consideration. The "lapse of time between the completion or reduction to practice of an invention and the filing of an application thereon" is not relevant to an affidavit or declaration under 37 CFR 1.131. See *Ex parte Merz*, 75 USPQ 296 (Bd. App. 1947).

As a result, because the earliest date presented on exhibit C occurs after the reference date, diligence cannot be shown to have begun prior to the effective date of the reference. Additionally, the Examiner notes that lapses in times need to be addressed/accounted for when attempting to meet the diligence requirement.

In response to the Applicants argument that Saito et al. does not cure the rejection of claim 8, the Examiner disagrees. FIG. 10+ of Saito et al., including FIG. 13 and 15, show displaying a page on a displaying, selecting a demarcation point on a page and using that point as the defined sub section delimiter, where a document is input, divided into areas, where the areas are interpreted as selecting a demarcation point and using that as a sub section delimiter. Applying to a plurality of pages is an obvious expedient such as when the document has more then one page to produce expected results (duplicating a process from a single page to a plurality of pages).

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL WALSH whose telephone number is (571)272-2409. The examiner can normally be reached on M-F 9am-7pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Paik can be reached on 571-272-2404. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status

Art Unit: 2887

information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DANIEL WALSH/
Primary Examiner, Art Unit 2887